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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

08048.0027-00

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Application Number

10/084,939

Filed

March 1, 2002

First Named Inventor

Jean-Louis H. GUERET

Art Unit

3732

Examiner

Robyn K. Doan

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

☒

attorney or agent of record.

Registration number 38,742

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

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571-203-2774

Telephone number

June 29, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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*Total of 1 forms are submitted.

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Attorney Docket No. 08048.0027-00

THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Jean-Louis H. GUERET) Group Art Unit: 3732
)
Application No.: 10/084,939) Examiner: Robyn K. Doan
)
Filed: March 1, 2002) Confirmation No.: 8280
)
For: BRUSH AND METHOD OF MAKING)
BRUSH)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant respectfully requests a pre-appeal brief review of this application.

I. Claim Objection

In the final Office Action, claims 15, 21, 120, and 150 were objected to based on allegations that claims 21 and 150 “duplicate[]” claims 15 and 120, respectively.” Final Office Action at 2. Applicant respectfully traverses the objection because claims 21 and 150 differ in scope from claims 15 and 120.

In particular, claim 15 recites, in part, “the core is located off-center in the cross-section of the brush over at least a portion of the length of the brush.” In contrast, claim 21 recites, in part, “the core passes through a point other than the center of the cross-section of the brush at at least one location along the length of the core.” Concerning claims 120 and 150, claim 120 recites, in part, “the envelope surface on the convex side of the curve defines a substantially planar surface along at least a portion of the length of the brush, the substantially planar surface intersecting the plane of curvature.” In contrast, claim 150 recites, in part, “the envelope surface on the convex side of the curve defines a substantially rectilinear edge along at least a portion of the length of the brush.” Therefore, claims 15 and 21 and claims 120 and 150 are not “duplicate[]” claims with respect to one another.

II. Claim Rejection under 35 U.S.C. § 102(e) based on Vasas

In the final Office Action, claims 1, 15-19, 21-24, 26-31, 45-49, 51-54, 56-60, 210, 233, 235-238, 264, and 293 were rejected under 35 U.S.C. § 102(e) based on Vasas (U.S. Patent No. 6,237,609). Applicant respectfully traverses the rejection of independent claims 1, 31, and 210 under § 102(e) based on Vasas because Vasas fails to disclose all of the subject matter recited in each of those independent claims. See M.P.E.P. § 2131.

The Vasas reference does not disclose or suggest all of the subject matter recited in Applicant's independent claim 1. Request for Reconsideration filed January 13, 2006 ("Request"), at 4-5. In the final Office Action, the Examiner asserts that "Vasas shows the core passes through the center of the cross-section of the very distal end of brush (12), see fig. 3, also, the core being centered horizontally and vertically at the very distal end and it is noted that Applicant has not claimed the shape of the brush with a circular cross-section, therefore, it meets the claimed limitations." Final Office Action at 7-8.

Applicant respectfully notes that Vasas does not mention or otherwise disclose that "the core [of the Vasas brush] passes through the center of the cross-section of the brush" at the "very distal end" of the brush shown in Fig. 3, as asserted by the Examiner. Figs. 2 and 3 of Vasas each show views of the Vasas brush depicted in Fig. 1. Fig. 2 clearly discloses that the Vasas core does not pass through the center of the cross-section of the brush, even at its "very distal end." As a result, Fig. 2 contradicts the Examiner's assertion that Fig. 3 "shows the core passes through the center of the cross-section of the very distal end of brush (12)" Furthermore, since Vasas does not refer to the core passing through the center of the brush cross-section, the Examiner is apparently relying on her own estimation of exact measurements shown in Fig. 3 in an apparent attempt to support her assertion that Fig. 3 allegedly shows the core passing through the center of the brush cross-section. This is contrary to prevailing patent law, under which it is improper to make such estimations in the absence of disclosure indicating that the drawing figures are scale drawings. Since Vasas does not indicate that Fig. 3 is a scale drawing, the Examiner's rejection based on her estimations concerning the dimensions shown in Fig. 3 is legally improper.

The Examiner also appears to be asserting that she has interpreted the term, "center," as recited in independent claim 1, to mean the midpoint with respect to only one axis, and that a cross-section must be circular in order for the term "center" to mean the mid-point relative to more than one axis. Such assertions and the apparent interpretation of claim 1 are clearly erroneous. For at least these reasons, the rejection of independent claim 1 under § 102(e) based on Vasas is improper.

The Vasas reference does not disclose or suggest all of the subject matter recited in Applicant's independent claim 31. Request at 5-6. In the final Office Action, the Examiner asserts that "figs. 8 and 10 show[] the curvature at 76 and at 84 with the length of the bristles on one side of the curvature being longer than the bristles on the other side of the curvature" ¹ Final Office Action at 8.

Figures 8 and 10 of Vasas simply do not disclose or suggest "an envelope surface of [a] brush . . . , [] wherein, in the plane of curvature, the distance from the convex side of the curve to the envelope surface varies along at least a portion of the length of the core," which is recited in independent claim 31. For at least this reason, the rejection of independent claim 31 under § 102(e) based on Vasas is improper.

The Vasas reference does not disclose or suggest all of the subject matter recited in Applicant's independent claim 210. Request at 6-7. In the final Office Action, the Examiner asserts that "Figure 5 [of Vasas] shows the brush with varying width dimension at 54 and at 56 (col. 2, lines 40-42)." Final Office Action at 8. Applicant respectfully disagrees at least because Fig. 5 and col. 2, lines 40-42, fail to disclose "a varying width dimension, the width dimension passing through the core and being perpendicular to the plane of curvature," as recited in independent claim 210. For at least this reason, the § 102(e) rejection of independent claim 210 based on Vasas is improper.

¹ The Examiner has apparently misinterpreted independent claim 31, at least because claim 31 does not recite "the curvature . . . with the length of the bristles on one side of the curvature being longer than the bristles on the other side of the curvature," as the Examiner asserts is disclosed by Vasas.

III. 35 U.S.C. § 103(a) Claim Rejection - Gueret in Combination with Vasas

In the final Office Action, claims 1, 3, 4, 6, 7, 31, 33-37, 61, 64-67, 75-79, 81-89, 91, 93-96, 104-108, 110-120, 122-126, 134-138, 140-149, 150, 152-156, 164-168, 170-179, 210, 212-216, 224-228, 230-233, and 235-239 were rejected under 35 U.S.C. § 103(a) based on Gueret (U.S. Patent No. 5,853,011) in combination with Vasas. Applicant respectfully traverses the § 103(a) rejection of each of independent claims 1, 31, 61, 91, 120, 150, and 210 based on the hypothetical combination of Gueret and Vasas because the Office Action has failed to establish a *prima facie* case of obviousness. Request at 7-9.

In the final Office Action, the Examiner refers to an alleged holding in a prior, irrelevant U.S. patent case having facts distinguishable from those of the present rejection, and asserts that “the motivation to combine Vasas curved core into the brush of Gueret is to improve curling and building mascara as well as providing heavier coating mascara (col. 2, lines 30-42).” Final Office Action at 8. Applicant respectfully notes that rather than responding directly to Applicant’s written remarks concerning how the Examiner’s proposed modification might possibly result in the Gueret brushes’ intended make-up effects possibly being altered, the Examiner has merely cited alleged advantages disclosed in Vasas and implied that any device would benefit from those alleged advantages, regardless of whether the modification might possibly alter the intended function of the device. The Examiner’s position is clearly contrary to the current state of the law of obviousness. For at least this reason, the Examiner’s proposed, hypothetical combination of Gueret and Vasas is improper.

IV. 35 U.S.C. § 103(a) Claim Rejection - Gueret in Combination with Kingsford

In the final Office Action, claims 180, 182-186, 195-198, and 200-209 were rejected under 35 U.S.C. § 103(a) based on Gueret in combination with Kingsford (U.S. Patent No. 5,137,038). Applicant respectfully traverses the § 103(a) rejection of independent claim 180 based on the hypothetical combination Gueret and Kingsford at least because the final Office Action has failed to establish a *prima facie* case of obviousness for reasons at least similar to those outlined above with respect to the § 103(a) rejection based on Gueret in combination with Vasas. Request at 9-

11. Moreover, the Examiner has failed to directly respond to Applicant's written remarks included in the Request concerning how the Examiner's proposed modification might possibly result in the Gueret brushes' intended make-up effects being possibly altered. Such alteration renders the Examiner's proposed, hypothetical combination of Gueret and Kingsford legally improper.

V. Rejection of Dependent Claims under 35 U.S.C. § 103(a)

In the final Office Action, dependent claims 25, 55, and 234 were rejected under 35 U.S.C. § 103(a) based on Vasas, and dependent claim 194 was rejected under 35 U.S.C. § 103(a) based on Gueret in combination with Kingsford and Vasas. Dependent claims 25, 55, 194, and 234 should be allowable for at least the same reasons their corresponding independent claim is allowable.

VII. Conclusion

As outlined above, independent claims 1, 31, 61, 91, 120, 150, 180, and 210 should be allowable. Each of the dependent claims pending in the application should be allowed. Request at 13. Furthermore, each of the withdrawn independent and dependent claims should be rejoined and allowed. Id. at 11-13.

Applicant respectfully requests reconsideration of this application, withdrawal of the outstanding claim objection and rejections, and allowance of claims 1-297.

Please grant any extensions of time required to enter this Request and charge any additional required fees to our Deposit Account No. 6-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: June 29, 2006

By: 

Christopher T. Kent
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